

REMARKS

Claims 1 through 9 are pending in this Application. Claims 1 and 3 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure, noting the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue.

Claim 1 was rejected under the second paragraph of 35 U.S.C. §112.

In the statement of rejection the Examiner asserted that the recitation in line 9 with respect to a member covering a surface layer region of the section is unclear. This rejection is traverse.

Claims 1 and 3 have been amended for clarification. Adverting to claim 1 which is the subject of this rejection, the recited steps indicate that the portion (14) which appears throughout Figs. 1B through 7, designated as the outer lead portion, has a removable member 15 (Figs. 1B through 6) thereon. The lead frame is placed in a mold and a sealing resin provided therein. After the lead frame sealed with a resin is removed from the mold, the removable member 15 along with sealing resin 41 thereon are removed from the outer lead portion 14, as shown in progressing from Fig. 6 to Fig. 7 noting the related discussion thereof in the written description of the specification at page 11, lines 10 through 22.

Based upon the foregoing it should be apparent that one having ordinary skill in the art would have no difficulty understanding the scope of the invention defined in claim 1, particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d

870, 27 USPQ2d 1123 (Fed. Cir. 1993). Applicants, therefore, submit that the imposed rejection of claim 1 under the second paragraph of 35 U.S.C. §112 is not viable and, hence, solicit withdrawal thereof.

Claim 1 was rejected under 35 U.S.C. §103 for obviousness predicated upon Ichikawa et al. in view of Yamauchi.

Claim 2 was rejected under 35 U.S.C. §103 for obviousness predicated upon Ichikawa et al. in view of Yamauchi and Utsumi et al.

Claim 3 was rejected under 35 U.S.C. §103 for obviousness predicated upon Ichikawa et al. in view of Yamauchi.

Claims 4 through 9 were rejected under 35 U.S.C. §103 for obviousness predicated upon Ichikawa et al. in view of Yamauchi, Utsumi et al and the acknowledged prior art.

Each of the above rejections under 35 U.S.C. §103 is traversed. Specifically, each of the above rejections under 35 U.S.C. §103 is predicated primarily upon Ichikawa et al. But each of independent claims 1 and 3 is directed to a method wherein a removable member, positioned on an outer lead portion of a lead frame, is removed subsequent to removing the outer lead frame sealed with a resin from the metal mold. This argument was presented in the responsive amendment submitted January 5, 2004. However, the Examiner, as explained in the ultimate paragraph on page 6 of the March 24, 2004 Office Action, maintained the rejection asserting it was unclear from which section a member was being removed. However, by the present Amendment, independent claims 1 and 3 have been clarified by reciting that the removable member, positioned on the outer lead portion prior to placing the lead frame in a mold cavity, is removed subsequent to removing the lead frame sealed with the resin from the mold.

The Examiner does not gainsay that Ichikawa et al. fail to disclose or suggest the concept of removing a removable member covering an outer lead portion subsequent to removing the lead frame sealed with a resin from the metal mold. This basic shortcoming of the primary reference to Ichikawa et al. is not remedied by any of the secondary references. Accordingly, even if the methodology of Ichikawa et al. is modified as suggested by the Examiner, in view of the secondary references, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed inventions would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claim 1 under 35 U.S.C. §103 for obviousness predicated upon Ichikawa et al. in view of Yamauchi, the imposed rejection of claim 2 under 35 U.S.C. §103 for obviousness predicated upon Ichikawa et al. in view of Yamauchi and Utsumi et al., the imposed rejection of claim 3 under 35 U.S.C. §103 for obviousness predicated upon Ichikawa et al. in view of Yamauchi and the imposed rejection of claims 4 through 9 under 35 U.S.C. §103 for obviousness predicated upon Ichikawa et al. in view of Yamauchi, Utsumi et al and the acknowledged prior art, are not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: June 17, 2004